

Remarks

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

The Office Action is final. Upon entry of the present Amendment, claims 1, 3-5, 7 and 9-10 are pending in the present application. Claims 1, 5 and 7 have been amended to further clarify and define the invention. Support for the amendments to claims 1, 5 and 7 can be found on page 13, lines 3-6 of the present specification.

Entry of the Amendment is proper under 37 C.F.R. § 1.116, since the amendments are made in response to arguments raised in the final rejection, and place the application in condition for allowance.

Entry of the present Amendment is respectfully requested.

Statement of the Substance of the Interview

Applicants' representative thanks Examiner Paden for the telephone interview of September 16, 2010. Applicants' representative submits that the Substance of the Interview within the Interview Summary dated September 22, 2010, is accurate.

Rejection Under 35 U.S.C. §103(a)

Claims 1, 3-5, 7 and 9-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bundus, U.S. Patent No. 3,488,198 (hereinafter "Bundus") as further evidenced by Potter, Food Science, Second Edition, The Avi Publishing Company, Westport, CT, p. 347 (1973) (hereinafter "Potter") and Swern, Bailey's Industrial Oil and Fat Products, Vol. 1, John Wiley and Sons, New York, pp. 315 and 318 (hereinafter "Swern").

Applicants respectfully traverse the rejection.

The Examiner asserts that the present application is obvious in light of the above references, as indicated on pages 2-4 of the outstanding Office Action.

Based on the following, Applicants contend that the Examiner's position is not supportable, and that the presently claimed invention is therefore unobvious over the cited references.

Although Applicants disagree, in order to advance prosecution, Applicants have amended claims 1, 5 and 7 to include the subject matter of claims 2, 6 and 8 (*i.e.*, rutin and tocopherol) within these claims.

The presently claimed invention, as exemplified by amended claim 1, is directed to a process for producing an oil-in-water type emulsion for light-exposing food which comprises mixing ingredients comprising fat, nonfat milk solids, emulsifier and water into a mixture, pre-emulsifying the mixture, pasteurizing or sterilizing the mixture, and homogenizing the mixture. The fat consists of non-milk fat, or non-milk fat and milk fat; the non-milk fat has such a constituent fatty acid composition that the total amount of lauric acid and palmitic acid is not less than 40%, the total amount of oleic acid, linoleic acid and linolenic acid is not more than 50%, and the total amount of linoleic acid and linolenic acid is not more than 5%. The ratio of milk fat/total fat is not more than 0.95 and the content of nonfat milk solids is 1 to 14% by weight; the amount of the fat ingredient is 15 to 48% by weight. The emulsifier is free from an unsaturated fatty acid, and tocopherol and rutin are added to the oil-in-water type emulsion before undergoing photodegradation.

As indicated in MPEP § 2143, the Examiner must resolve the factors described in *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), which provides the controlling framework for an obviousness analysis, before utilizing the rationales that were established in *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Differences between the Invention and the Cited References

Applicants provide the following information regarding the *Graham* factor of ascertaining the differences between the prior art and the claims that are at issue.

As indicated, claims 1, 5 and 7 include the combination of tocopherol and rutin. As discussed during the interview, the cited references do not disclose or suggest the combination of tocopherol and rutin within processes for producing an oil-in-water type emulsion for light-exposing food or a method for preventing photodegradation of an oil-in-water type emulsion.

Additionally, Applicants submit that the synergistic effect of the combination of tocopherol and rutin within the presently claimed invention is not obvious.

Applicants submit that based on the differences discussed above, the Examiner has not resolved the *Graham* factor of ascertaining the differences between the prior art and the claims that are at issue, and therefore the rationale the Examiner provides for the rejection is improper.

Applicants submit that the differences between the prior art references and the presently claimed invention are clear. Applicants submit that taking the above *Graham* analysis in mind, the combination of cited references do not lead to the presently claimed invention.

In light of the above amended claims and remarks, Applicants submit that the assertions made by the Examiner regarding the cited references are incorrect, thus failing to support the Examiner's position. Accordingly, based on the differences between the presently claimed invention and the above references, they do not teach or suggest the presently claimed invention.

The secondary references, Potter and Swern, fail to remedy the deficiencies of the Bundus reference.

Since amended claims 1, 5 and 7 are not obvious to one of ordinary skill in the art, claims 3, 4, 9 and 10, which depend from claims 1 and 7, are unobvious over the cited references for the same reasoning discussed above.

Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102(b), or in the Alternative, 35 U.S.C. § 103(a)

Claims 1, 3, 5, 7 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated, or in the alternative, rejected under 35 U.S.C. § 103(a) as unpatentable over Bundus as further evidenced by Potter and Swern.

Applicants respectfully traverse the rejection.

The Examiner asserts on pages 4-6 of the Office Action that claims 1, 3, 5, 7 and 9 are anticipated by or obvious over the Bundus reference.

Based on the following, Applicants contend that the Examiner's position is not supportable, thus the Bundus reference neither anticipates nor renders obvious the presently claimed invention.

Differences between the Presently Claimed Invention and the Bundus Reference

Applicants have amended claims 1, 5 and 7 to include the subject matter of claims 2, 6 and 8 (*i.e.*, rutin and tocopherol) within these claims.

Applicants submit that based on amended claims 1, 5 and 7, the Bundus reference does not teach or disclose the presently claimed invention. Accordingly, Applicants submit that Bundus is silent concerning the above features as presently claimed. Thus, the presently claimed invention is clearly distinguished from the Bundus reference.

Therefore, Bundus does not teach each and every feature of amended claims 1, 5 and 7.

See MPEP § 2131 - to anticipate a claim, the reference must teach every element of the claim.

Accordingly, claims 1, 5 and 7 are not anticipated by the Bundus reference. Since claims 3 and 9 depend from claims 1 and 7, respectively, these claims are not anticipated by the Bundus reference for the same reasoning above.

With regard to the alternative rejection under 35 U.S.C. § 103(a), Applicants incorporate by reference the comments from the previous 35 U.S.C. § 103(a) rejection. Applicants submit that based on amended claims 1, 5 and 7, the Bundus reference does not teach or suggest the presently claimed invention.

Applicants respectfully submit that based on the differences between the presently claimed invention and the Bundus reference, the presently claimed invention is not obvious to one of ordinary skill in the art.

Since claims 3 and 9 depend from claims 1 and 7, respectively, these claims are not obvious over the Bundus reference for the same reasoning above.

Therefore, Applicants respectfully submit that the Bundus reference neither anticipates nor renders obvious the presently claimed invention.

Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejection Under 35 U.S.C. §103(a)

Claims 2, 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bundus, as further evidenced by Swern and Potter as applied to claims 1, 3-5, 7, 9 and 10, and further in view of Arcadipane, U.S. Patent No. 5,393,551 (hereinafter “Arcadipane”).

Applicants have cancelled claims 2, 6 and 8, thus rendering moot the rejection as to these claims.

Applicants respectfully traverse the rejection as applied to claims 1, 5 and 7.

The Examiner asserts on page 6 of the Office Action (as applied to claims 1, 5 and 7) that the claims are obvious over the above references.

Applicants incorporate the above comments concerning the present invention and the cited references.

With regards to the Arcadipane reference, Arcadipane does not disclose or suggest the combination of tocopherol and rutin as indicated in the presently amended claims.

Therefore, the Swern, Potter and Arcadipane references fail to remedy the deficiencies of Bundus, outlined above.

In light of the above arguments and amended claims 1, 5 and 7, Applicants submit that the presently claimed invention is not obvious to one of ordinary skill in the art.

Applicants respectfully request reconsideration and withdrawal of the present rejection.

Conclusion

Applicants respectfully submit that all of the rejections raised by the Examiner have been overcome, and that the present application now stands in condition for allowance.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Paul D. Pyla at the telephone number below, in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 23-0975 for any additional fees required under 37 C.F.R. §§1.16 or 1.17.

Respectfully submitted,

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